

REMARKS

Applicant requests reconsideration and allowance of the present application in view of the following remarks.

Claims 1-13 are pending in the present application. Claims 1, 4, 5, and 10 are the independent claims.

No claims have been amended by the present Request.

Initially, Applicant acknowledges with appreciation the indication that claim 13 recites patentable subject matter and would be allowable if rewritten in independent form to include all of the features of the base claim and any intervening claims. By the present Request, Applicant has maintained amended claim 13 because it is respectfully submitted that a prima facie case of obvious has not been established against any independent claim.

Claims 1, 3-7, and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,114,028 (Green et al.) in view of U.S. Patent No. 6,876,615 (Shishido). Claims 2, 8, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Green et al. in view of Shishido, and further in view of U.S. Patent No. 7,106,665 (Lee). All rejections are respectfully traversed.

All rejections are respectfully traversed because the Office has failed to make out a prima facie case of obviousness.

Section 2142 of the Manual of Patent Examining Procedure (MPEP) explains that a prima facie case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to modify a reference. It is for this reason that the mere fact that a modification can be made is legally insufficient to support an obviousness rejection. (MPEP, § 2143.01). And, the Office bears the initial burden of factually supporting any prima facie conclusion of obviousness. (MPEP, § 2142).

If the Office does not establish a prima facie case, an Applicant is under no obligation to submit evidence of nonobviousness. (MPEP, § 2142). Applicants respectfully submits that such is the case in the present application.

A review of the Office Action reveals, at page 3, an apparent attempt to provide a rationale for the asserted modification of Green et al. Specifically, the Office Action states:

Therefore it would have been obvious to one ordinarily skilled in the art at the time of invention to supplement teachings of Green, and data ranging from a next writable address to a predetermined

block upon determining that the optical disc is a Minimal Blank disc in which data is erased from the recording management area to a lead-in area, in order to erase only the contents information of the track.

(Office Action, page 3).

It is submitted that this "attempt" is merely a conclusory statement, devoid of the required evidence to support a prima facie case. Indeed, absent from the Office Action is any evidence that one of ordinary skill would have been motivated to make the asserted modification. This "attempt" even begins with the conclusory "therefore." Moreover, this "attempt" appears to be incomplete because it does not even identify the knowledge with which Green et al. is to be supplemented ("... it would have been obvious to one ordinarily skilled in the art at the time of invention to supplement teachings of Green, and data ranging ...").

The Office has failed to meet its initial burden of factually supporting a prima facie conclusion of obviousness. Thus, Applicant is under no obligation to submit evidence of nonobviousness. (MPEP, § 2142).

Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 based on Green et al. are respectfully requested.

Regarding the rejections of claims 2, 3, 6, 8, and 11, Applicant respectfully submits that none of the secondary and tertiary citations, alone or in combination as the Office Action asserts, add anything that would remedy the aforementioned deficiency.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant believes that the present Request is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

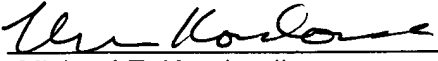
There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Request, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: 
Michael E. Kondoudis
Registration No. 42,758

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501